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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,890	02/16/2001	Robert M. Moore JR.	SU-7073-L	5058
65895 7590 03/30/2011 ALBEMARLE CORPORATION 451 FLORIDA STREET BATON ROUGE, LA 70801-1765				
EXAMINER				
PRYOR, ALTON NATHANIEL				
ART UNIT		PAPER NUMBER		
1616				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/785,890

**Applicant(s)**

MOORE ET AL.

**Examiner**

ALTON PRYOR

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/C2.06)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments filed 1/18/11 have been fully considered but they are not persuasive. See arguments below.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodenough et al. (US 3,558,503; 1/26/07) in view of Dallmier et al. (US 5,683,654; 11/4/97).

Goodenough teaches a method of producing an aqueous solution having bromine values of about 0.01 to about 100,000 ppmw useful for bleaching processes, treating swimming pools and disinfecting processes (column 1 lines 13-61). Goodenough teaches a method of producing an aqueous bromine solution comprising providing an aqueous solution of bromine and contacting therewith a bromine stabilizer such as sulfamic acid plus an amount of hydroxide such as magnesium hydroxide sufficient to achieve a final pH ranging from about 8 to about 10 (column 2 lines 1-40). Note, the mixing of magnesium hydroxide with sulfamic acid result in an alkaline metal salt of sulfamic acid which is functionally equivalent to the instant alkali metal salt (sodium) of sulfamic acid. Goodenough also teaches that the molar ratio of bromine to nitrogen (Br<sub>2</sub>:N<sub>2</sub>) ranges from about 2 to about 0.5, which would have indicated to an artisan that the atomic ratio of nitrogen to active bromine (N:Br) ranges from about 0.5 to about 2 (column 1 lines 66-69).

Dr. McKinnie's declaration low solubility of alkaline earth metal hydroxide (magnesium hydroxide in Goodenough) in water makes it impossible to make an aqueous solution having a pH of at least 13 when alkaline earth metal is the sole source of hydroxide. The Examiner maintains that Goodenough's method of making a final solution having a bromine content of about 100,000 ppmw differs from the method recited in Moore's claim 11 in the pH of the resulting biocide composition. That is, Goodenough's method yields a biocide having a pH of from about 8 to about 10 (Example 3) whereas Moore's claimed method yields in a biocide having a pH ranging from 13.0 to 14.0. The prior art provided that motivation to modify the method of Goodenough with a reasonable expectation of success. The modification of Goodenough makes the stability results provided in Nalepa's Declaration obvious.

Dallmier discloses a process that "improves on the Goodenough et al. reference by means of a safer, easier, and more economical process." (column 2 lines 45-47). As confirmed by Moore's own expert, Dallmier suggests that a sulfamic acid stabilized hypobromite such as N-bromosulfamate can be stored in a high pH solution ranging from about 8 to about 14 and more preferably from about 11 to about 14 with minimal suspected carcinogen bromate formation. (column 3 lines 28-3; column 4 lines 47-49; column 9 line 65 – column 10 line 60). As taught by Dallmier, the formation of bromate occurs from a reaction involving hypobromite as a reactant and stabilized hypobromite (column 3 lines 24-26; column 10 lines 1-8).

Hence, an artisan would have been motivated to combine the teachings of Goodenough and Dallmier. It would have been obvious to modify Goodenough's process to include a step of increasing the pH of the final solution to 13-14 as indicated in Dallmier in order to minimize the

formation of the suspected carcinogen bromate during storage, thus arriving at a method encompassed by Moore's claims 11-30.

Neither Goodenough et al. nor Dallmier et al. teach the use of BrCl as bromine source or the instant ordering of steps to yield biocide. Note, Goodenough uses a bromine sources that yield a solution having 100,000 ppmw bromine content. Although the bromine source differs from the BrCl claimed in Goodenough's invention, the final bromine content of 100,000 ppmw bromine in Goodenough reads on the instantly claimed bromine content. For this reason, it is obvious that the solution yielded in Goodenough would be equivalent to the instant solution in terms of chemical and physical properties. Therefore, it is expected that both solutions would exhibit similar biocidal activity. In the absence of an unexpected showing for the instant ordering of steps, the combination of Goodenough and Dallmier make instant ordering of steps obvious. Note, the active steps in the prior art and instant process involves the mixing of the same chemicals: bromine source, sulfamic acid and base. Since the chemical composition is the same for the prior art invention and instant invention, it is expected that the composition yielded in both the prior art and instant claims to show a similar activity, unless a showing is provided demonstrating the significance of the instant ordering of steps.

#### Response to Applicants' Argument

The major focus of Applicants' argument is on BrCl and how it truly exists. Applicants recite the use of BrCl which is not isolated from Br<sub>2</sub> plus Cl<sub>2</sub>, water, sulfamic acid and alkali metal sulfamate. Applicants admit that although the claims recite BrCl, the BrCl contains many other components. The Examiner argues that claims do not show proper representation for BrCl, because according to Mills et al., Tellinghuisen, Farkas and Lewin, Second declaration of Dr.

McKinnie Applicants argue that in Goodenough et al. it is not possible to form and handle pure BrCl. According to the cited literature noted above BrCl in the presence of Br<sub>2</sub>, Cl<sub>2</sub>, H<sub>2</sub>O, sulfamic acid, alkali metal sulfamate yields BrCl in equilibrium with Br<sub>2</sub> and Cl<sub>2</sub>, hypochlorite, hypobromous, hypochlorite, hypobromite, HOBr, HCl, bromide and chloride. Hence, the Applicants do not show a true representation of BrCl in the claims. Applicants argue that N-chlorosulfamate is produced inherently in the present invention. The Examiner argues that Goodenough et al can produce N-chlorosulfamate. Goodenough et al. discloses the mixture of sulfamic acid, calcium chloride or sodium chloride and bromine. Note, inherently Goodenough et al. produces N-chlorosulfamate when the chloride (calcium or sodium) reacts with bromine to produce BrCl which is followed by the reaction of the BrCl with sulfamic acid to yield N-chlorosulfamate and N-bromosulfamate.

The Examiner reiterates that an artisan would have been motivated to combine the teachings of Goodenough and Dallmier. It would have been obvious to modify Goodenough's process to include a step of increasing the pH of the final solution to 13-14 as indicated in Dallmier in order to minimize the formation of the suspected carcinogen bromate during storage, thus arriving at a method encompassed by Moore's claims 11-30.

Applicants provide data showing that the magnesium hydroxide in Goodenough et al. is not chemically equivalent to the sodium hydroxide in present claims with respect to the nature of this invention (Table). The Examiner argues that the results in the Table are not convincing since the Table shows only Bromine for the two Goodenough et al. examples instead of the BrCl that can be automatically derived from Goodenough et al combination of chemicals (sulfamic acid, calcium chloride or sodium chloride and bromine). In addition the Table shows only 0.125 moles

of hydroxide for the Goodenough et al. whereas the Table discloses 2.025 moles hydroxide for the present invention. This Table does not appear to show a side by side comparison of instant invention versus Goodenough et al.'s invention.

Applicants argue that there is no reason for an artisan in the field to combine Dallmier et al. with Goodenough et al. Dallimer et al. addresses the problems of the handling issues and corrosive nature associated with diatomic halogens. Dallmier et al. teaches that the addition of base after the halogen addition to the solution, whereas Goodenough et al. claims better results when base is added bromine to the solution. Dallmier et al. teach that their order of addition steps is critical. Thus, it would have not been obvious to combine Dallmier et al. with Goodenough et al. whose order of addition steps differ.

In the absence of an unexpected showing for the instant ordering of steps, the combination of Goodenough and Dallmier make instant ordering of steps obvious. Note, the active steps in the prior art and instant process involves the mixing of the same chemicals: bromine source (BrCl instant application and BrCl can be derived from the chlorides being combined with bromine in Goodenough et al.), sulfamic acid and base. Since the chemical composition is the same for the prior art invention and instant invention, it is expected that the composition yielded in both the prior art and instant claims to show a similar activity, unless a showing is provided demonstrating the significance of the instant ordering of steps. The Examiner argues that the results in the Table are not convincing since the Table shows only Bromine for the two Goodenough et al. examples instead of the BrCl that can be automatically derived from Goodenough et al combination of chemicals (sulfamic acid, calcium chloride or sodium chloride and bromine). In addition the Table shows only 0.125 moles of hydroxide for

the Goodenough et al. whereas the Table discloses 2.025 moles hydroxide for the present invention. This Table does not appear to show a side by side comparison of instant invention versus Goodenough et al.'s invention. Until a side-by-side comparison is done, the instant combination of references makes the 12 wt % - 18 wt % active bromine obvious.

### **Telephonic Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616



